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In re Application of
GALLI et al.
Application No.: 09/647,939
PCT No.: PCT/EP99/02624
Int. Filing Date: 19 April 1999
Priority Date: 20 April 1998
Attorney Docket No.: P66004US0
For: SOURCE OF NUCLEI FOR NUCLEAR
TRANSFER

NOTIFICATION

This communication is in response to applicants' "SECOND REQUEST FOR REFUND" filed 16 July 2001.

BACKGROUND

On 19 April 1999, applicants filed international application PCT/EP99/02624, which claimed a priority date of 20 April 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 28 October 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 19 November 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 20 October 2000.

On 18 October 2000, applicants filed a TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee of \$860 and the surcharge under 37 CFR 1.492(e) of \$130 for filing the oath or declaration later than thirty months from the priority date; an authorization to charge any additional fees set forth in 37 CFR 1.492 to Deposit Account No. 06-1358; and a preliminary amendment. These application papers were identified by applicants with attorney docket number P66004US0 and were assigned application number 09/647,939.

On 20 October 2000, applicants filed a second TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee of \$860 and the surcharge under 37 CFR 1.492(e) of \$130 for filing the oath or declaration later than thirty months from the priority date; an authorization to charge

any additional fees set forth in 37 CFR 1.492 to Deposit Account No. 06-1358; and a preliminary amendment. These application papers were identified by applicants with attorney docket number P64474US0 and were assigned application number 09/673,236.

On 06 November 2000, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form DO/EO/905) for application number 09/647,939 indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required.

On 17 November 2000, applicants submitted a "REQUEST FOR REFUND AND WITHDRAWAL OF APPLICATION" stating that through inadvertent error and mistake, application number 09/647,939 and application number 09/673,236 were identical. Applicants stated that "[i]nsofar as Serial No. 09/647,939 is concerned, this application is herewith expressly withdrawn as being a duplicate of U.S. Serial No. 09/673,236" and requested that the payment of \$990 made on 18 October 2000 be refunded.

On 29 November 2000, the USPTO mailed NOTICE OF CANCELLATION OF ASSIGNED SERIAL NUMBER (Form PCT/DO/EO/908) in application number 09/647,939 indicating that the assigned serial number 09/673,236 has been cancelled. This Notice indicated that the transmittal letter filed 20 October 2000 identified itself as a first submission of items concerning a filing under 35 U.S.C. 371 and was incorrectly assigned a new serial number. The Notice also indicated that assigned serial number 09/647,939 should be used when filing papers in the USPTO.

On 31 May 2001, the USPTO charged Deposit Account No. 06-1358 a \$270 multiple dependent claim fee for application number 09/647,939.

On 01 June 2001, the USPTO mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that application number 09/647,939 was abandoned for failure to respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 06 November 2000.

On 16 July 2001, applicants submitted a "SECOND REQUEST FOR REFUND" requesting that Deposit Account 06-1358 be refunded the \$990 paid on 18 October 2000 because that application was "withdrawn" and the \$270 charged to Deposit Account No. 06-1358 on 31 May 2001 because this application was "withdrawn" and because a preliminary amendment was filed on 18 October 2001 cancelling the multiple dependency.

DISCUSSION

As is evident from the above recited facts, applicant submitted two sets of papers to enter the national stage for the same international application. The submission of two sets of national stage papers to enter the United States was improper.

35 U.S.C. 363 states:

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in 102(e) of this title. (emphasis added)

Further, 35 U.S.C. 371(b) states:

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty. (emphasis added)

The language of 35 U.S.C. 363 and 371 refers to the national stage of the PCT in the singular only, and thus only one (1) national stage application in the U.S. may develop from an international application. Both the Transmittal Letter filed 18 October 2000 and the Transmittal Letter filed 20 October 2000 indicate that each submission is a "filing under 35 U.S.C. 371" of PCT/EP99/02624. No conflicting instructions appear in the application papers. Accordingly, each submission should have been treated as a national stage application submitted under 35 U.S.C. 371. In that only one national stage of a PCT application is permitted, it was proper for both the submission filed 18 October 2000 and the submission filed 20 October 2000 to be placed in a single application and assigned a single application number. Accordingly, all of the papers filed on 20 October 2000 have been placed in application number 09/647,939. As noted in the NOTICE OF CANCELLATION OF ASSIGNED SERIAL NUMBER mailed 29 November 2000, application number 09/673,236 has been cancelled.

Applicant should use application number **09/647,939** in all future communications with the Patent and Trademark Office in regards to the U.S. national stage of international application PCT/EP99/02624.

The submission filed by applicants on 17 November 2000 states that "[i]nsofar as Serial No. 09/647,939 is concerned, this application is herewith expressly withdrawn as being a duplicate of U.S. Serial No. 09/673,236." It is not clear what is meant by this statement. If applicants' intent is to *withdraw* the international application, such action can not be approved after 30 months from the priority date. Furthermore, if applicant did withdraw the international application, entry into the national stage would not be permissible under 35 U.S.C. 366 which states, in part, "Subject to section 367 of this part, if an international application designating the United States is withdrawn or considered withdrawn, either generally or as to the United States, under the conditions of the treaty and the Regulations, before the applicant has complied with the applicable part requirements prescribed by section 371(c) of this part, the designation of the United states shall have no effect after the date of withdrawal and shall be considered as not having been made" If applicants' intent is to expressly *abandon* U.S. application number 09/647,939, then an express abandonment should be filed. (It should be kept in mind, however, that application number 09/673,236 has been cancelled, as set forth above.)

Fees

The fees accompanying the submission identified by applicants as having attorney docket number P64474US0 were refunded on 30 November 2000. The \$270 multiple dependent claim fee charged to Deposit Account 06-1358 on 31 May 2001 will be credited to that account; the preliminary amendment filed 18 October 2000 removed any multiple dependent claims.

CONCLUSION

For the reasons set forth above, the submission filed 18 October 2000 and the submission filed 20 October 2000 have been placed in the file of application number 09/647,939.

For the reasons set forth above, the request for refund is granted-in-part to the extent that the \$270 charged to Deposit Account No. 06-1358 on 31 May 2001 will be credited to that Deposit Account.

For the reasons set forth in the NOTIFICATION OF ABANDONMENT mailed 01 June 2001, this application remains ABANDONED as to the United States.

Applicants may wish to consider filing a petition under 37 CFR 1.137 to revive the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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